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| 09/632,248 | 08/03/2000 | Wolfgang Maus | E-41007 | 1144 |

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EXAMINER

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1764

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GROUP 1700

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/632,248
Filing Date: August 03, 2000
Appellant(s): MAUS, WOLFGANG

Laurence A. Greenberg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/12/04.

Art Unit: 1764

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of the Claimed Subject Matter*

The summary of the claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on Appeal in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 2-3, 6-11 stand or fall with claim 1 and claims 13-15, 18-19 and 21-22 stand or fall with claim 12 and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 1764

(9) Prior Art of Record

| | | |
|--------------|----------------|---------|
| US 4,344,922 | SANTIAGO ET AL | 08-1982 |
| US 4,999,168 | TEN EYCK | 03-1991 |
| US 6,077,483 | LOCKER ET AL | 06-2000 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3, 7-8, 12-15, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Locker et al (6,077,483).

With respect to claims 1-2, 7-8, 12-14, 19, Locker et al discloses a catalytic exhaust gas purification device comprising:

a steel casing 16;

Art Unit: 1764

a monolithic ceramic honeycomb element 10 mounted in said casing 16;

a compensating layer disposed between said casing 16 and said honeycomb element 10;

said compensating layer comprising:

a swelling mat or intumescent mat 14 with border regions at risk from abrasion;

an insulating layer 12 having a border and an inner region; said border of said

insulating layer 12 having a thicker region 12A than said inner region; and

said swelling mat 14 being disposed adjacent a side of said inner region of said

insulating layer 12 facing away from said honeycomb element 10 and said thicker

region 12A of said border of said insulating layer 12 covering said border regions

of said swelling mat 14 at risk from abrasion (Fig. 2);

said compensating layer is wrapped around the honeycomb element 10 (col. 7, lines 15-53).

With respect to claims 3, 15, Locker et al discloses that the insulating layer contains ceramic material (col. 4, lines 15-40).

Instant claims 1-3, 7-8, 12-15, 19 structurally read on the apparatus of Locker et al.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1764

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 6 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Locker et al (6,077,483) in view of Ten Eyck (4,999,168).

Since it is unclear as to what structural limitation applicant is attempting to recite as set forth above, as best understood, the apparatus of Locker et al is substantially the same as that of the instant claims, but fails to disclose whether the swelling mat may swell upon absorbing water.

However, Ten Eyck discloses the conventionality of providing a swelling mat containing mica as that of the instant invention and therefore inherently swells upon absorbing water (col. 5, lines 40-44).

It would have been obvious to one having ordinary skill in the art to alternatively select an appropriate material for the swelling mat, such as mica, as taught by Ten Eyck in the apparatus of Locker et al on the basis of its suitability for the intended use as a matter of obvious design choice to obtain the desired supporting and insulating the catalyst element thereof, absence showing any unexpected results and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In *re Leshin*, 125 USPQ 416.

Art Unit: 1764

6. Claims 9-11, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Locker et al (6,077,483) in view of Santiago et al (4,344,922) and Ten Eyck (4,999,168).

The apparatus of Locker et al is substantially the same as that of the instant claims, but fails to disclose whether the compensating layer may be prefabricated segments.

However, Santiago et al and Ten Eyck disclose the conventionality of providing a compensating layer in form of prefabricated segment.

It would have been obvious to one having ordinary skill in the art to use the compensating layer in prefabricated segment form as taught by Santiago et al and Ten Eyck in the apparatus of Locker et al, on the basis of its suitability for the intended use as a matter of obvious design choice to obtain the desired supporting the catalyst element thereof, absence showing any unexpected results.

(11) Response to Argument

In several places in the brief,

1) Appellant argues that the barrier coatings in Locker et al provide a rigid rather than resilient base against which the intumescent layer may more efficiently apply retention pressure while the instant mat may inherently be flexible, windable, foldable, compressible and may have the ability of damping and resilience since based on the definition of Merriam-Webster Online Dictionary that the “mat” means a piece of course, woven, plaited, or felted fabric. Appellant further argues that all of the properties of the instant mat can be derived from the instant specification on page 4, line 2; page 7, line 15 and page 12, line 9).

Such contention is not persuasive as the instant claims do not require the resilient base and also there is nothing recited in the instant claim to exclude the rigid base of Locker et al. It is

Art Unit: 1764

unclear as to where it is disclosed in the instant specification that the instant mat possesses all of the above properties.

It should be noted that the term “mat” does not have only one meaning as alleged by appellant, it has also other meanings, such as a pad or a slab of reinforced concrete (e.g. rigid) to be used as a supporting base or a piece of material (which can be rigid or flexible) placed at the door for wiping soiled shoe soles. Therefore, all of the properties as alleged by appellant, such as flexible, etc. ... are not inherent therein.

The statement on page 4, line 2 of the instant specification appears to describe the mat of the DE 297 09 180. The statements on page 7, line 15 and page 12, line 9 of the instant specification have nothing to do with the exclusion of the rigid base of Locker or the inclusion of the resiliency of the instant mat.

It should be pointed out that the use of mat is conventional in the prior art and the mat can possess different properties based on the composition of the material of the mat. Since the instant claims do not define any of such to differentiate the instant mat from that of Locker et al and therefore the mat of Locker et al meets the mat of the instant claim.

2) Appellant argues that in Locker et al, there is a large bonding surface and at least partially no separate surfaces exist between the coatings and the substrate while the mat of the instant claim is wrapped or wound around the honeycomb which means that there are well-defined surfaces of each component.

Such contention is not persuasive as the language of the instant claims is not commensurate in scope with such argument; e.g. the language of the instant claims does not

Art Unit: 1764

exclude the bonding surface, if there is any, nor require separate surfaces between the coating and the substrate.

Furthermore, Fig. 2 of Locker et al shows that the coatings 12 and the substrate do have separate surfaces (note the separate surfaces one each side of the bold line between substrate 10 and the coatings 12).

The phrase of “wrapped or wound” appears to direct to the method of forming the product. It should be noted that if a product of the instant claim is the same as or would have been obvious to one having ordinary skill in the art from a product of the prior art, the product is unpatentable even though the prior art product was made by different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

In this case, Locker et al discloses a catalytic converter having all of the structural elements set forth in the instant claims, e.g. a casing, a honeycomb element and a compensating layer therebetween. Since the product of Locker et al is substantially the same as that of the instant claim, the product as recited in the instant claim is unpatentable even though the product of Locker may be made by different process.

3) Appellant argues that the gap and cavities may occur between the honeycomb and the mat.

However, as set forth above, the language of the instant claims is not commensurate in scope with such argument, e.g. the language of the instant claims does not require the gap and cavities between the honeycomb and the mat.

Art Unit: 1764

4) Appellant argues that in the instant application, the method used to locate the compensating layer between the casing and the honeycomb element does make a difference in the structure of the final product.

Such contention is not persuasive as no difference in the structure of the final product is defined by the instant claim. As admitted by appellant, the instant claim is a product-by-process claim. As set forth above, when the patentability of a product-by-process claim is determined, the relevant inquiry is whether the product itself is patentable. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). If a product is the same as or would have been obvious to one having ordinary skill in the art from a product of the prior art, the product is unpatentable even though the prior art product was made by different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). Since the product of the instant claim is substantial the same as that of Locker et al, it is unpatentable even though the product of Locker et al was made by different process.

(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 1764

Respectfully submitted,

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HT

January 21, 2005


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